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No. 56.

In the Supreme Court of the United States.

OCTOBER TERM, 1906.

THE UNITED STATES EX REL. GEORGE A. LOWRY AND PLANTERS COMPRESS COMPANY, PLAINTIFFS IN ERROR,

v.

FREDERICK I. ALLEN, COMMISSIONER OF PATENTS.

IN ERROR TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

BRIEF FOR THE UNITED STATES.

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STATEMENT.

This is a writ of error to the Court of Appeals of the District of Columbia to review a judgment denying the right to a mandamus to the Commissioner of Patents directing him to permit an appeal within his office in an interference case and reversing the Supreme Court of the District which, without opinion, granted the writ.

The interference was declared under section 4904, Revised Statutes, between a patent granted to plaintiffs in error and an application filed by one Spoon, both relating to a cotton bale. Plain-

tiffs' patent, No. 661475, was granted in 1900. Spoon's application was filed September 10, 1901. The interference was declared to determine the priority of invention. (Sec. 4904, Rev. Stat.) Plaintiffs alleging it was without good reason, moved dissolution. The primary examiner denied the motion and they appealed to the examiners in chief. (Sec. 4909, Rev. Stat.) This appeal was dismissed, and thereafter they applied to the Supreme Court of the District for a mandamus commanding the Commissioner "to cause to be reinstated and to reinstate and take jurisdiction of your petitioners' said appeal, and to entertain and consider the merits thereof, and decide the same upon the merits."

The petition in substance alleges—

That Lowry as inventor and the Planters' Compress Company as assignee secured patent No. 661475 upon a bale of fibrous material;

That an interference was declared between that patent and application No. 74985, filed by Spoon, covering a bale of fibrous material;

That Lowry moved to dissolve the interference under rule 122, and his motion was granted;

That Spoon thereupon appealed to the examiners in chief, who affirmed the decision;

That Spoon took an appeal to the Commissioner in person and also filed a petition asking him "to remand the said interference to the primary examiner for reconsideration of the question of operativeness of the Spoon press to make the issue

bale and for leave to file affidavits in support of operativeness;"

That this petition was granted, and afterwards the examiner "found the Spoon press operative to make the issue bale, if the press of Lowry was operative to make the issue bale, and reversed previous decisions dissolving the interference;"

That Lowry thereupon appealed to the examiners in chief under sections 482 and 4909 Revised Statutes;

That Spoon moved to dismiss the appeal for lack of jurisdiction and the motion was granted; and that the Commissioner of Patents refused to direct them to hear and determine the same.

Alleging it was the duty of the examiners in chief to determine the appeal and that upon their refusal the Commissioner should direct them so to do, petitioners prayed for an appropriate writ of mandamus.

The Return—

The defendant in error admitted the various actions set forth in the petition but denied it was the duty of the examiners-in-chief to entertain and decide the appeal. He declared "that the primary examiner's decision was not the rejection of a claim or a final adverse decision in the interference, but was a mere ruling upon an interlocutory motion and was not appealable. He further avers that the decision was not adverse to Lowry's claimed rights as the patentee, since that is the very matter to be determined in the interference pro-

ceeding which the primary examiner refused to dissolve. Lowry will have the right of appeal, if at all, only in case the final decision in the interference is adverse to him." (R., 12–21.)

Replication—

Plaintiffs filed a replication (R., 13, 14), practically admitting the examiner's decision was interlocutory and not final and alleging that the right of appeal from such a ruling existed.

No written opinion was filed by the trial court. The elaborate opinion of the Court of Appeals appears in the record at page 29, and to it especial attention is invited.

Statutes and Patent Office Rules—

> R. S., SEC. 4904. Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners in chief, as the case may be, within such time, not less than twenty days, as the Commissioner shall prescribe.
>
> R. S., SEC. 4909. Every applicant for a

patent or for the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners in chief, having once paid the fee for such appeal.

R. S., SEC. 4910. If such party is dissatisfied with the decision of the examiners in chief he may, on payment of the fee prescribed, appeal to the Commissioner in person.

R. S., SEC. 4911. If such party, except a party to an interference, is dissatisfied with the decision of the Commissioner he may appeal to the Supreme Court of the District of Columbia, sitting in banc.

SEC. 9. (Act of February 9, 1893.) That the determination of appeals from the decision of the Commissioner of Patents, now vested in the general term of the Supreme Court of the District of Columbia, in pursuance of the provisions of section seven hundred and eighty of the Revised Statutes of the United States, relating to the District of Columbia, shall hereafter be and the same is hereby vested in the Court of Appeals created by this act; and in addition, any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said Court of Appeals.

R. S., SEC. 482. The examiners in chief shall be persons of competent legal knowledge and scientific ability, whose duty it

shall be, on the written petition of the appellant, to revise and determine upon the validity of the adverse decisions of examiners upon applications for patents, and for reissues of patents, and in interference cases; and, when required by the Commissioner, they shall hear and report upon claims for extensions, and perform such other like duties as he may assign them.

R. S., SEC. 483. The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

RULE 93. An interference is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention. The fact that one of the parties has already obtained a patent will not prevent an interference, for altho the Commissioner has no power to cancel a patent, he may grant another patent for the same invention to a person who proves to be the prior inventor.

RULE 97. When an interference is found to exist and the applications are prepared therefor, the primary examiner will forward to the examiner of interferences the files and drawings; notices of interference for all the parties (as specified in Rule 103), disclosing the name and residence of each party and that of his attorney, and of any

assignee, and, if any party be a patentee, the date and number of the patent; the ordinals of the conflicting claims and the title of the invention claimed; and the issue, which shall be clearly and concisely defined in so many counts or branches as may be necessary in order to include all interfering claims. Where the issue is stated in more than one count the respective claims involved in each count should be specified. The primary examiner shall also forward to the examiner of interferences for his use a statement disclosing the applications involved in interference, fully identified, the name and residence of any assignee, and the names and residences of all attorneys, both principal and associate, and arranged in the inverse chronological order of their filing as completed applications, and also disclosing the issue or issues and the ordinals of the conflicting claims.

Whenever it shall be found that two or more parties whose interests are in conflict are represented by the same attorney, the examiner will notify each of said principal parties, and also the attorney, of this fact.

RULE 101. Upon the institution and declaration of the interference, as provided in Rule 102, the examiner of interferences will take jurisdiction of the same, which will then become a contested case; but the primary examiner will determine the motions mentioned in Rule 122, as therein provided.

RULE 102. When the notices of interference are in proper form, the examiner of interfer-

ences will add thereto a designation of the time within which the preliminary statements required by Rule 110 must be filed, and will, *pro forma*, institute and declare the interference by forwarding the notices to the several parties to the proceeding.

RULE 108. When applications are declared to be in interference, the interfering parties will be permitted to see or obtain copies of each other's file-wrappers, and so much of their contents as relate to the interference, after the preliminary statements referred to in Rule 110 have been received and approved; but information of an application will not be furnished by the office to an opposing party, except as provided in Rules 97 and 103, until after the approval of such statement.

RULE 110. Each party to the interference will be required to file a concise preliminary statement, under oath, on or before a date to be fixt by the Office, showing the following facts:

(1) The date of original conception of the invention set forth in the declaration of interference.

(2) The date upon which a drawing of the invention was made.

(3) The date upon which a model of the invention not claimed as a reduction to practise was made.

(4) The date upon which the invention was first disclosed to others.

(5) The date of the reduction to practise of the invention.

* * * * *

RULE 122. Motions to dissolve an interference upon the ground that no interference in fact exists, or that there has been such irregularity in declaring the same as will preclude a proper determination of the question of priority, or which deny the patentability of an applicant's claim, or his right to make the claim, should, if possible, be made not later than the twentieth day after the statements of the parties have been received and approved.

[The foregoing was amended July 31, 1906, so as to read: *Motions to dissolve an interference* (*1*) *upon the ground that there has been such informality in declaring the same as will preclude a proper determination of the question of priority of invention, or* (*2*) *which deny the patentability of an applicant's claim, or* (*3*) *which deny his right to make the claim, or* (*4*) *which allege that counts of the issue have different meanings in the cases of different parties*, should, if possible, be made not later than the *thirtieth* day after the statements of the parties have been received and approved.] Such motions, and all motions of a similar character, should be accompanied by a motion to transmit the same to the primary examiner, and such motion to transmit should be noticed for hearing upon a day certain before the examiner of interferences. When in proper form the motion presented will be transmitted by the examiner of interferences, with the files and papers, to the proper primary examiner for his determination, who will thereupon fix a day certain

when the said motion will be heard before him upon the merits, and give notice thereof to all the parties. If a stay of proceedings be desired, a motion therefor should accompany the motion for transmission.

When the motion has been decided by the primary examiner, if no appeal has been taken therefrom, at the expiration of the time limited for appeal the examiner will return the files and papers, with his decision, to the examiner of interferences. Such decision will be binding on the examiner of interferences unless reversed or modified on appeal. (Rule 124.)

Motions to shift the burden of proof should be made before and will be determined by the examiner of interferences. No appeal from the decision on such motions will be entertained, but the matter may be reviewed on appeal from the final decision upon the question of priority of invention.

RULE 124. Appeal may be taken directly to the Commissioner from decisions on all motions except the following: (1) On motions to dissolve which deny the patentability of applicant's claim; (2) on motions to dissolve which deny the right of an applicant to make the claim; (3) on motions involving the merits of the invention. Decisions on these motions, when appealable, go to the examiners in chief, *in the first instance*, and upon such appeals the questions *shall* be heard *inter partes*.

From a decision of the primary examiner affirming the patentability of the claim or

the applicant's right to make the same no appeal can be taken.

[Rule 124 was amended July 31, 1906, to read: *Where, on motion for dissolution, the primary examiner renders an adverse decision upon the merits of a party's case, as when he holds that the issue is not patentable, or that a party has no right to make a claim, or that the counts of the issue have different meanings in the cases of different parties, he shall at once reject such claims as may be affected and shall set a time for reconsideration; after reconsideration, if he adheres to his original conclusion, he will make the previous rejection final and fix a limit of appeal. The appeal must go to the examiners in chief in the first instance and will be heard inter partes. If the appeal is not taken within the time fixed, it will not be entertained except by permission of the Commissioner.*

No appeal will be permitted from a decision rendered upon motion for dissolution affirming the patentability of a claim or the applicant's right to make the same or the identity of meaning of counts in the cases of different parties.

Appeals may be taken directly to the Commissioner, except in the cases provided for in the preceding portions of this rule, from decisions on such motions as, in his judgment, should be appealable.]

RULE 126. The examiner of interferences or the examiners in chief may, either before or in their decision on the question of priority, direct the attention of the Commissioner to

any matter not relating to priority which may have come to their notice, and which, in their opinion, establishes the fact that no interference exists, or that there has been irregularity in declaring the same (Rule 122), or which amounts to a statutory bar to the grant of a patent to either of the parties for the claim or claims in interference. The Commissioner may, before judgment on the question of priority, suspend the interference and remand the case to the primary examiner for his consideration of the matters to which attention has been directed. From the decision of the examiner appeal may be taken as in other cases. If the case shall not be so remanded, the primary examiner will, after judgment, consider any matter affecting the rights of either party to a patent which may have been called to his attention, unless the same shall have been previously disposed of by the Commissioner.

RULE 130, July 31, 1906. Where the patentability of a claim to an opponent is material to the right of a party to a patent, said party may urge the nonpatentability of the claim to his opponent at final hearing before the examiner of interferences as a basis for the decision upon priority of invention, and upon appeals from such decision. A party shall not be entitled to take such step, however, unless he has duly presented and prosecuted a motion under Rule 122 for dissolution upon the ground in question, or shows good reason why such a motion was not presented and prosecuted.

146. In interference cases parties have the same remedy by appeal to the examiners in chief, to the Commissioner, and to the Court of Appeals of the District of Columbia, as in *ex parte* cases.

Practise in Patent Office on motion to dissolve interference and the questions involved in Lowry's motion to dissolve.

There are in the Patent Office forty primary examiners, each of whom has charge of applications relating to inventions concerning which he has expert knowledge. When he finds a conflict between two applications otherwise allowable he declares an interference and sends the papers to the examiner of interferences to determine who was the first inventor and entitled to the patent.

There is only one examiner of interferences who takes charge of all interferences declared by the forty primary ones. Neither examiner is superior to the other, and all are tribunals of original jurisdiction, having charge of different questions.

The board of three examiners in chief has jurisdiction to entertain appeals from a primary examiner rejecting claims and from decisions of the examiner of interferences in interference cases.

The primary examiner necessarily declares interferences, since he is the only one who examines all applications relating to his art and who primarily knows when claims conflict. Before declaring an interference, the examiner must consider and decide whether the parties claim the

same invention, and whether the invention would be patentable under any circumstances. He makes decision without a hearing. Under the rules applications are preserved in secrecy. After an interference is declared and parties have filed their preliminary statements, each is permitted to see his opponent's papers. (Rule 108.)

As the original declaration of interference is made *ex parte*, it is the practise to permit either party to move for its dissolution. The motion is in effect a request for reconsideration, after argument, of the action declaring the interference, and raises only those questions which should have been originally considered by the examiner. It is now and has been for a great many years the practise of the Patent Office to have preliminary motions to dissolve interferences determined by the primary examiner who declared the interference, and they are permitted only at the beginning of the proceedings before taking testimony. All other preliminary and interlocutory motions as to the conduct of the proceedings are made before and determined by the examiner of interferences. The officials of the Patent Office have considered it wise thus to divide the jurisdiction as to preliminary matters. All of these might have been left for determination by the examiner of interferences, and there is nothing to prevent the Commissioner from so changing the present practise.

The Commissioner may, on interlocutory appeal, review rulings upon certain preliminary questions by the examiner of interferences and primary examiners under Rule 122. In neither case is the review granted because of statutory requirement, but because in the exercise of administrative discretion this seems wise. This right of review, however, is limited by the rule which provides for it. (Rule 124.) Such appeals are in the nature of special interlocutory appeals and are matters of discretion.

Rule 124 permits review of some decisions by the examiners-in-chief and others by the Commissioner. When a motion to dissolve is *granted* because the claim constituting the subject-matter of controversy is not patentable, or because one party has no right to make that claim, an appeal lies to the examiners-in-chief. In such a case, unless the matter is then reviewable, the decision obviously ends the interference. If the motion is *denied* there is no immediate review, but the examiners-in-chief pass on the entire subject upon appeal from the final judgment. Rule 124 provides there shall be no interlocutory appeal from a finding that the issue is patentable or that a party has the right to make the claim.

The "right of an applicant to make the claim," mentioned in the rule, has nothing whatever to do with anything done or rights acquired by the opposing party in the interference. It has refer-

ence solely to the applicant's *ex parte* right to a patent upon his application. If, e. g., the application is insufficient to support the claim, or device disclosed is found inoperative, the applicant has no right to make the claim. A finding favorable to his right is not a decision in itself adverse to the claim of the opposing party, since the latter may be the first inventor and show it by proof.

Question involved in Lowry's motion—

The present interference was declared because in his application Spoon made a claim the same as one appearing in Lowry's patent. Where two parties claim the same thing an interference is necessary in order to decide between them, and to determine whether the applicant is entitled to the patent sought.

The petition for mandamus states (R., 2–3) Lowry's motion for dissolution alleged that Spoon's press as disclosed in his application is inoperative, and that therefore he has no right to make the claim. Admittedly, Spoon makes plaintiffs' patented claim, but it is alleged he has no right to. The examiner ruled there was nothing upon the face of the papers showing Spoon's press inoperative, and the parties should proceed with the interference by taking proof. The question of operativeness is the only thing particularly mentioned in the petition for mandamus as having been decided by the examiner.

ARGUMENT.

I.

The decisive question is whether it was the plain, clear ministerial duty of the Commissioner of Patents to permit plaintiffs' appeal to the examiners in chief from the primary examiner's refusal to dissolve the interference.

In *Ex Parte Cutting* (94 U. S., 14)—a petition for mandamus to compel allowance of an appeal—this court said the petitioners must "show that they have a clear right to an appeal, which has been refused."

High's Extraoradinary Legal Remedies, 248:

> But to warrant the interference in this class of cases it must appear that the person seeking the relief is clearly entitled to an appeal, and when this does not appear the writ will be refused. And mandamus will not lie to compel a court to settle a statement for the purpose of an appeal from a judgment which is only interlocutory and from which no appeal lies. Nor will the writ go to compel the allowance of an appeal from orders, the granting of which rests wholly within the discretion of the court.

Under the statutes an interference is declared solely "to determine the question of priority of invention." No such determination was made in the present interference. Lowry's motion was a request that the proceeding be stopt or dissolved

without deciding that point, and he seeks to appeal from a refusal. He did not ask judgment in his favor, but that no judgment as to priority be rendered.

Defendant maintains that the decision complained of is interlocutory and can not be reviewed on a direct appeal before the final judgment.

The following propositions are advanced:

1. The examiner's refusal to dissolve the interference does not terminate it and is not final.

2. Preliminary and interlocutory rulings are not appealable prior to final judgment unless expressly made so by statute.

> It is a universal rule that, except as provided by statute, no appeal can be prosecuted from a proceeding taken prior to final judgment or decree. (Enc. of Pl. & Pr., vol. 2, p. 81.)

3. The same doctrine applies to patent appeals, and no statute expressly makes interlocutory matters appealable.

4. To permit appeals on interlocutory motions in interferences would protract litigation in the Patent Office to an unbearable degree. The general terms in section 4909, Revised Statutes, do not require such a result.

5. The decision mentioned in section 4909—on the question of priority of invention—is the only one which section 4904 requires the Patent Office to render.

6. When the examiners in chief were created and right of appeal to them in interference cases given (sec. 2, act Mar. 2, 1861, 12 Stat., 246), and when section 4909, Revised Statutes, in its present words became law, the rules of the Patent Office did not permit interlocutory motions to dissolve interferences. Such motions were not permitted until 1871, ten years after the passage of the original act relating to appeals. Rulings upon such motions were not, therefore, the decisions from which that section was designed to give appeals.

7. If the question raised by motion to dissolve so affects the rights of parties to the interference as to permit a review, it should be on appeal from the final decision.

8. So long as plaintiffs may appeal from the final judgment they are adequately protected. This right is clearly given by new Rule 130 and never denied by any rule.

9. At no time since the board of examiners in chief was established has the Patent Office permitted appeal to them from preliminary or interlocutory decisions denying motions to dissolve interferences. This uniform and long-continued construction of the law by the officials is entitled to great weight.

II.

The statutes do not provide for interlocutory appeals.

The statutes do not specifically mention interlocutory rulings as appealable, but plaintiffs claim their terms are so broad as to include them.

The word in the statutes is undoubtedly broad, but that only a final decision is referred to is reasonably clear. Congress framed the law with knowledge that by long usage the term "decision" in a suit or judicial proceeding means a final determination and not a mere preliminary ruling. If a different use of the word had been intended that would have been made clear. All interlocutory rulings are included, if any are.

Section 4904, Revised Statutes, specifically provides for a decision on "priority of invention" and an appeal therefrom, and no other in an interference is specifically mentioned in the statutes. The decision mentioned in section 4909 is the one described in section 4904.

The statutes do not state how questions are to be raised and determined in interference proceedings, and the Commissioner has made controlling rules.

By analogy to court practise interlocutory motions in interferences should be allowed, as has been done for many years. Analogy to the same practise prohibits appeals from rulings on such motions.

III.

No reasons exist for presuming an intent to make interlocutory rulings in interferences appealable prior to a final judgment.

A consideration of the nature of interferences shows they are much like proceedings in equity, and present no greater reasons for permitting piecemeal appeals and prolonged litigation. An equity suit instituted under section 4918, Revised Statutes, touching conflicting patents is strictly analogous to an interference in the Patent Office. Before the grant of the patent the proceeding is in the Patent Office and afterwards in the courts. The question at issue is the same in both cases and the procedure similar.

The judicial character of interference proceedings was declared by this court in *United States* v. *Duell* (172 U. S., 576):

> Now, in deciding whether a patent shall issue or not, the Commissioner acts on evidence, finds the facts, applies the law, and decides questions affecting not only public but private interests; and so as to reissue, or extension, or on interference between contesting claimants; and in all this he exercises judicial functions.

Congress likewise recognized their judicial nature by providing an appeal to the Court of Appeals of the District.

If plaintiffs may appeal to the examiners-in-chief under section 4909 from the examiner's

refusal to dissolve an interference, they may further appeal to the Commissioner under section 4910 and to the Court of Appeals under section 4911, Revised Statutes, and section 9, act of February 9, 1893. Section 4909 says "every party to an interference may appeal" to the examiners-in-chief; section 4910 refers to section 4909 and adds "such party" may appeal to the Commissioner; and section 9, act of February 9, 1893, provides "any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said Court of Appeals."

In *Westinghouse* v. *Duncan* (66 O. G., 1009; 2 App. D. C., 131)—appeal to the Court of Appeals upon refusal by the Patent Office of motion to reform the issue—the court said:

> In our opinion it was not the intention of Congress, in the employment of the general terms of the statute, to grant the right of appeal to this court from mere interlocutory or preliminary orders or rulings in interference proceedings. By such rulings no definite determination of the merits of the case is made. The ultimate determination in such cases by the Commissioner of Patents is of the question of priority of invention, and that is the only decision from which an appeal will lie to this court in such cases.

In *Cross* v. *Phillips* (87 O. G., 1399, 14 App. Cases, 228), the same court said:

> Appeals do not lie to this court from all or any preliminary decisions in matters of

interference, though seriously affecting the rights of the parties, but only from those wherein the priority of the claim to the invention has been finally awarded. (*Westinghouse* v. *Duncan*, C. D., 1894, 170; 66 O. G., 1009; 2 App. D. C., 131, 134.)

If, then, the exercise of the discretion of the Commissioner in the matter of allowing and refusing leave to amend preliminary statements be subject to review at all, it must be confined to those cases where the question comes up properly with the appeal from the decision on the merits, and where it can be made clearly to appear that this discretion has been abused to the extent of causing a palpable miscarriage of justice.

In *Hulett* v. *Long* (89 O. G., 1141, 15 App. Cases, 284), the court said:

The questions raised upon this motion to dissolve were of an interlocutory character and did not involve in their determination the question of priority of invention, and from the determination of such questions as those raised by the motion no appeal is allowed to this court. The appeal allowed to this court by the act of Congress of February 9, 1893, in cases of interference is for the purpose, and that alone, of having the final decision of the Commissioner of the Patent Office on the question of priority of invention reviewed and determined as that question is contemplated and provided for in section 4904 of the Revised Statutes of the United States, and not for the purpose of

> having decisions upon collateral or interlocutory questions reviewed and decided. If all such collateral and interlocutory proceedings in the Patent Office were the subjects of appeal to this court, the proceedings for patents might be made almost interminable, to say nothing of the enormous costs that would be incurred in prosecuting and defending against such appeals.

Innumerable preliminary and interlocutory questions may be raised in interference proceedings, and experience has shown they are often used to delay or harass opponents. The court below, in reference to this, said (R. 31)—

> It is known to all who are familiar with the practice in interference proceedings that by motions, petitions, and appeals of every conceivable character that the ingenuity of the skilled attorney can devise interferences can be and are prolonged for years, to the injury of the public, and often to the financial ruin of the parties. It does not appear when the present interference was declared, but in view of all the proceedings had, as disclosed by the record, it has been a long time, and no testimony has yet been taken. Should we affirm the decision of the court below, the reasons for which are not set forth, and reverse the practice of the Patent Office as it has stood unchanged for at least twenty-five years, we would be placing still another burden of successive piecemeal appeals upon the unfortunate interferant. * * *

IV.

Circumstances surrounding passage of appeal statute show interlocutory motions are not appealable.

It may be urged that section 4909, Revised Statutes, referred to an existing state of things in the Patent Office, and, when construed in the light of the practise, means that interlocutory motions should be appealable.

Any such view would be refuted by an examination of the rules from 1861 to the present. They did not permit an interlocutory motion to dissolve an interference in 1861, when the original act permitting appeals to the examiners in chief was past, nor in 1870, when the act in its present form was enacted. No such motion was permitted until August 1, 1871.

In the appeal act, therefore, the lawmakers were not referring to the interlocutory motions, but to the only decision then being rendered by the Patent Office in interference cases, namely, one upon priority of invention.

Section 2, act of March 2, 1861, follows:

> SEC. 2. And be it further enacted, That, for the purpose of securing greater uniformity of action in the grant and refusal of letters patent, there shall be appointed by the President, by and with the advice and consent of the Senate, three examiners in chief, at an annual salary of three thousand dollars each, to be composed of persons of competent legal knowledge and scientific

> ability, whose duty it shall be, on the written petition of the applicant for that purpose being filed, to revise and determine upon the validity of decisions made by examiners when adverse to the grant of letters patent; and also to revise and determine in like manner upon the validity of decisions of examiners in interference cases, and when required by the Commissioner in applications for the extension of patents, and to perform such other duties as may be assigned to them by the Commissioner; that from their decisions appeals may be taken to the Commissioner of Patents in person, upon payment of the fee hereinafter prescribed; that the said examiners in chief shall be governed in their action by the rules to be prescribed by the Commissioner of Patents.

The act of 1870 contained the provisions of section 4909.

The first reference in the rules to a dissolution of the interference because improperly declared is found in the edition of August 1, 1869, eight years after the passage of the appeal act.

Rule 58 of that edition:

> Cases of interference will, when the issue is made up and the testimony taken, be tried before an examiner specially detailed for that purpose. If an interference has been properly declared, it will not be dissolved without judgment of priority, founded upon the testimony or the written concession of one of the parties.

This was the only rule referring to the subject when the act of 1870 passed.

Rule 59 of July 5, 1870:

> Cases of interference will, when the issue is made up and the testimony taken, be tried before the examiner in charge of interferences. If an interference has been properly declared, it will not be dissolved without judgment of priority, founded upon the testimony or the written concession of one of the parties, unless the invention is found not to be patentable, or to have been abandoned, or that it has been in public use for more than two years prior to the application of either party, or that no interference in fact exists.

The rules of August 1, 1871, included the following (Rule 59):

> A motion for a dissolution of an interference on the ground that it was improperly declared, if made before the taking of testimony, will be heard by the primary examiner who declared the interference.

This was the first provision for an interlocutory motion for dissolution. In the rules of September 1, 1873, it was changed, as follows:

> A motion for a dissolution of an interference on the ground that it was improperly declared, if made before the taking of testimony, will be heard by the primary examiner who declared the interference. Upon such hearing the primary examiner will recommend the granting or refusal of such

motion, and the examiner in charge of interferences will order accordingly. (Last paragraph of Rule 59.)

In the rules of April 1, 1875, it was further changed as follows:

> 59. An interference will not be declared until the subject-matter involved is decided to be patentable. If after being declared it is found that no interference in fact exists, or that there has been such irregularity in declaring the same as will preclude the proper determination of the question of right between the parties it will be dissolved, and an appeal may be taken to the Commissioner in person.

The rules of November 1, 1876, contained the following:

> 59. After the declaration of the interference and before the time for filing the preliminary statements has expired, motions to dissolve the same on the ground of lack of novelty, or that no interference in fact exists, or that there has been such other irregularity in declaring the same as will preclude the proper determination of the question of right between the parties, must be made before the examiner by whom the interference was instituted. An appeal from his decision may be taken to the Commissioner in person; but if the examiner should decide that the subject-matter is not patentable in view of the state of the art

the interference will be dissolved and the matter decided upon can be proceeded with ex parte.

With slight modifications this continued in force until May, 1879, when it was directed that all such motions should be made before the Commissioner.

On December 1, 1879, the following rules were adopted:

116. Motions to dissolve an interference which deny the patentability of an applicant's claim, or his right to make the claim, will be submitted to the examiner of interferences before the day fixed for filing the statements provided for in rules 97, 101, and 102, and will be transmitted by him, with the files and papers, to the primary examiner, who will take jurisdiction of the case for the determination of such motions, and will return the files and papers to the examiner of interferences, with his decision, at the expiration of the time limited for appeal, if no appeal shall have been taken, or sooner if the party entitled to appeal shall file a waiver in writing of his right of appeal; and such decision will be binding on the examiner of interferences unless revised or modified on appeal. From a decision of the primary examiner on such motion, denying the patentability of a claim or the right of an applicant to make it, an appeal may be taken ex parte to the examiners in chief; but from his decision affirming its patentability or the applicant's right no appeal can be taken.

117. Motions to dissolve an interference upon the ground that no interference in fact exists, or that there has been such irregularity in declaring the same as will preclude the proper determination of the question of priority between the parties, and all other lawful motions except those mentioned in rule 116, will be made before the tribunal having jurisdiction at the time. * * *

118. Appeal may be taken directly to the Commissioner from decisions on all motions, except motions to dissolve interferences denying the patentability of applicant's claims, or their right to make the claims, and other lawful motions involving the merits of the case, which, when appealable, may be appealed to the board of examiners in chief. (See Rules 116, 141.)

These rules contain the provisions to which plaintiffs object. The Patent Office has never permitted appeals to the examiners in chief from the refusal of an interlocutory motion to dissolve an interference.

V.

Rules of Patent Office permit review of interlocutory ruling with final judgment, and are not inconsistent with law.

Rule 122 provides that the primary examiner shall pass upon motions for dissolution and that his decision thereon is binding upon the examiner of interferences; but it does *not* provide that such conclusion is binding upon the appellate tribunals.

Nothing prevents the examiners in chief, the Commissioner of Patents, or the Court of Appeals from reviewing the action of the primary examiner upon appeal from a final decision. If the ruling of the primary examiner so influences the disposition of the case by the examiner of interferences as to lead to an erroneous final judgment, that may be reviewed and reversed. The rules do not cut off the right of review, but merely regulate the procedure and time therefor. This is not unreasonable and is in line with the practise of courts.

The court below in this case said (R., 38–39):

> * * * whatever right a party to an interference has to contest the right of his adversary to make the interfering claim, such right, if denied, is reviewable, if at all, upon the final decision of the question of priority, and such right of appeal as he has to have that question decided is to be considered on the hearing of the statutory appeals allowed from the decision of the question of priority by the examiner of interferences.

(See *Cross* v. *Phillips*, 14 App. Cases, 228; *Seeberger* v. *Dodge*, 114 O. G., 2382 (Jan., 1905); *Podlesak* v. *McInnerney*, 120 O. G., 2127; 26 App. Cases, 399.)

Amended Rules 122 and 124, and Rule 130 above quoted, make it clear the examiners in chief and the Commissioner will review, on appeal from final decision, the question which plaintiff in error now seeks to force them to consider.

In the case of *Pohle* v. *McKnight* (119 O. G., 2519), the Commissioner of Patents reviewed and determined a question similar to that raised by plaintiffs in error, but he did it upon appeal from a final decision. This was prior to the last amendment of the rules.

VI.

Ruling that Spoon has right to make claim is not final.

The examiner's ruling that Spoon has a right to make the claim embodied in plaintiffs' patent and that his press is operative, only means that Spoon made out a *prima facie* case. Plaintiffs may take proof to overcome the supposed *prima facie* case, or they may stand upon their motion—practically a demurrer—and allow judgment to be entered against them. They may then appeal and obtain a review by three successive appellate tribunals. They should not be permitted to take three appeals on the interlocutory ruling. It is no great hardship to require them to elect whether they will stand upon their demurrer or take proof.

The conclusion that in the absence of proof Spoon's press must be regarded as operative is a very different thing from a final decision to that effect. If Spoon's device were finally held operative it would still be necessary to determine whether plaintiffs' claim is superior. The ruling in question, therefore, does not approach a final decision against plaintiffs.

VII.

Long-established practise of the Patent Office is entitled to great weight.

The fact that the Patent Office has never permitted appeals to the examiners in chief from denial of an interlocutory motion to dissolve an interference, is entitled to much consideration.

The Commissioners of Patents were interested, were competent to judge of their meaning, and were undoubtedly informed as to the intentions and purposes of the several statutes. For forty odd years they have denied the right now claimed by plaintiffs.

No published decisions of the Commissioners exist prior to about 1870. Commissioner Leggett, August 23, 1871, in *Crane and Rogers*, C. D., 1871, said:

> The object of the interference is, by the law and by the office rules of practice, solely for the purpose of determining priority of invention between contending parties. There is no law for declaring or continuing an interference on any other question.
>
> The examiner of interferences has no jurisdiction of other matters, and therefore can give no final judgment except upon questions of priority of invention and such preliminary and interlocutory questions as may be necessary in determining priority.
>
> The board of examiners in chief and the

> Commissioner, while acting in his judicial capacity, are subject to the same limitations when trying interference cases.

That decision manifestly means interlocutory matters are to be considered upon appeal only so far as they affect the judgment upon the real question in the interference, and they are brought up by appeal from the final judgment.

In *Bate Refrigerating Co.* v. *Sulzberger* (157 U. S., 1; 70 O. G., 1633) this court said:

> * * * If the statute be not so explicit as to preclude construction; if upon applying to it the established rules of interpretation; if looking at it in the light of previous legislation on the subject; if there be reasonable ground for adopting one of two constructions, this court, without departing from sound principle, may well adopt that construction which is in harmony with the settled practice of the executive branch of the Government.

I respectfully ask that the judgment of the court below be affirmed.

J. C. McReynolds,
Assistant Attorney-General.

John M. Coit,
Attorney for the Commissioner.

October, 1906.

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